

REMARKS

Claims 1-5 are pending. No new matter has been added by way of the present submission. For instance, claims 1-5 have been amended to indicate that the nucleotide sequences are “muscle growth-related genes derived from muscle tissue of *Kagoshima Berkshire* in adult stage.” These amendments are supported by the present specification, for instance, page 1, lines 4-7, page 7, lines 10-15 and page 11, lines 21-24. Accordingly, no new matter has been added.

In the outstanding Office Action the Examiner has required Applicants to elect one of the following five groups pursuant to 35 U.S.C. §121.

I. Claim 1, drawn to a nucleotide sequence of a growth-related gene as set forth in SEQ ID NO: 1;

II. Claim 2, drawn to nucleotide sequence of a growth-related gene as set forth in SEQ ID NO: 2;

III. Claim 3, drawn to nucleotide sequence of a growth-related gene as set fort in SEQ ID NO: 3;

IV. Claim 4, drawn to nucleotide sequence of a growth-related gene as set forth in SEQ ID NO: 4; and

V. Claim 5, drawn to nucleotide sequence of a growth-related gene as set fort in SEQ ID NO: 5.

Applicants strongly traverse the Examiner’s restriction requirement. In a conventional restriction requirement, regardless of the election made, the Examiner will examine a reasonable

number of sequences. However, in the present instance the Examiner has restricted all five sequences. This is an improper restriction requirement and should be withdrawn.

The Examiner fails to provide any specific reason why each of the inventive sequences should be restricted. The Examiner has simply asserted that each of these sequences have no apparent relationship except that they were each isolated in the same screening procedure and are recited to be growth related. However, Applicants submit that this generic statement is unsupported by the present facts and insufficient to shift the burden to the Applicant. The Examiner has provided absolutely no evidence to explain why these sequences are distinct.

In fact, the present specification clearly identifies SEQ ID NOS 1-5 as being identified in the muscle tissue of pig in adult stage. That is, these five novel nucleotides (GF I, II, III, IV and V) relate to muscle growth and were identified using cDNA microarray technology. GFI, GFIII and GFV existed as single copies in the pig genome and GFII and GFIV existed as more than two copies. It was thus suggested that there are many isoforms of these genes in the pig genome.

Regardless, GFI, III and V existed as single copies in the genome and were expressed much more in the muscle of pig with a body weight of 90kg. This is in the muscle of a pig in adult stage. Moreover, these genes were not expressed in the propagation or fat tissues, only in the muscle tissue.

Accordingly, it is evident that the present nucleotide sequences are all growth related. And to a further extent, these sequences are muscle growth related. Accordingly, each of the present SEQ ID NOS:1-5 possess characteristics of function in common. The present claims have been amended to more clearly recite this common function. For this reason alone, the Examiner is requested to search and consider all claims.

Regardless of the present facts, to aid the biotechnology industry in protecting its intellectual property, the Commissioner has partially waived the requirements of 37 C.F.R. §1.141 *et seq.* to permit a “reasonable number” of nucleotide sequences to be claimed in a single application. *See Examination of Patent Applications Containing Nucleotide Sequences*, 1192 OG 68 (November 19, 1996). MPEP §803.04 explains that normally 10 sequences constitute a “reasonable number” of sequences for examination purposes. Thus, 10 independent and distinct nucleotide sequences should be examined in a single application without restriction. Exceptional cases that are outside of this practice include amino acid sequences reciting 3-dimensional folding. However, the present case is not one of these exceptional cases. Therefore, the Examiner’s restriction requirement is completely groundless and should be withdrawn.

Moreover, the current USPTO interpretation of a “reasonable number” of sequence being a single sequence is nonsensical. If such an interpretation were correct, there would have been no reason for the Commissioner to partially waive the requirements. Regardless, in order to be fully responsive Applicants hereby elect Group V, directed to SEQ ID NO:5. This is an election with traverse.

Favorable action on the merits is respectfully solicited.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.


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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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